

Application No.: 09/625,135

Docket No.: 20135-00290-US

REMARKS

Claims 1-17 are now in the application. Claims 8-17 are directed to the elected invention. Claims 1-7 are drawn to the non-elected invention and may be cancelled by the Examiner upon the allowance of the claims directed to the elected invention.

Claims 8, 11-13 and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,868,350 to Hoffarth, et al. (hereinafter also "Hoffarth").

X | Hoffarth fails to anticipate Claims 8, 11-13 and 16 since, among other things, Hoffarth does not suggest employing a dielectric composition between the sub-assemblies that is of the same material as the dielectric of the sub-assemblies. Hoffarth merely suggests employing low dielectric constant material for sub-assemblies and low dielectric material for the encapsulant binding layer, but does not disclose that such should be of the same material. In fact, the material of the sub-assemblies is preferably polytetrafluoroethylene (e.g., see Column 4, lines 10-11, Claims 10 and 15), and the encapsulant is preferably epoxy or chlorotrifluoroethylene (e.g., see Column 3, Lines 47-51; Col. 4, lines 27-30). Moreover, the bonding layers and dielectric are selected to differ since the binding is to space the dielectric from the conductive surfaces.

Therefore, Hoffarth fails to anticipate the above claims. In particular, anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, USPQ2d 1081 (Fed. Cir. 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. 102. See *Scripps Clinic and Research Foundation v. Genetech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

The law is well settled that claiming of a more specific range within a more generic range

Application No.: 09/625,135

Docket No.: 20135-00290-US

and/or claiming species from a broader group of possible compounds avoids a lack of novelty rejection. The test for anticipation is whether the claims read on the prior art disclosure, not on what the reference broadly teach.

For example, see *Akzo v. U.S. International Trade Commissioner*, 1 USPQ2d 241 (Fed. Cir. 1986). In *Akzo*, the claims that were drawn to a process for making aramid fibers using a 98% sulfuric acid were not anticipated by a reference using a concentrated sulfuric acid solution. The disclosure of a concentrated sulfuric acid was not deemed an inherent disclosure of the more specific 98% sulfuric acid.

The court further found that no anticipation exists when one would have had to "randomly pick and choose among a number of different polyamides, a plurality of solvents and a range of inherent viscosities" to reach the claimed invention.

Also see *In re Kollman, et al.* 201 USPQ 193 (CCPA-1979) wherein the court held that the prior art generic disclosure contains "no suggestion of the required FENAC/diphenyl ether ratio."

In Rem-Cru Titanium v. Watson 112 USPQ 88 (D.D.C-1956), the prior art showed alloys having broad ranges which included the claimed ranges. However, the prior art did not explicitly disclose the more limited ranges or alloys having the characteristics of the claimed alloy, which is analogous to the present case. Accordingly, the court held the claims to be allowable. For a similar factual pattern and same holding, please see *Becket v. Coe* (CA, DC 1938) 38 USPQ2d and *Tarak v Watson* (DC-DC 1954) 103 USPQ 78.

Also, see *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Ortho-Pedics, Inc.* 24 USPQ2d 1321 (Fed. Cir. 1992). Here the court held that although the claims may be subsumed in a prior art reference generalized disclosure, this is not literal identity. The reference ranges were "so broad as to be meaningless" and provided no guidelines on how to construct a product with the invention's attributes.

Application No.: 09/625,135

Docket No.: 20135-00290-US

Furthermore, the cited references do not inherently disclose the present invention. For instance, see *In re Robertson, et al* 49 USPQ2d 1949 (1999 Fed. Cir.). In this case, Robertson filed a patent application concerning a paper diaper. The application claimed a paper diaper having (a) two fasteners so that the diaper could be worn on a baby and (b) a third fastener for rolling up and fixing the used diaper. The Patent Office rejected the invention under 35 USC 102 based on "Principles of Inherency" as the invention is "anticipation" by the prior art.

The prior art (Wilson) relied upon disclosed a diaper which had two snaps in front and back of the diaper in order to be worn by a baby and which may further have a strip in order to fasten the diaper to baby's body. Wilson describes that the used diaper can be easily dealt with by rolling up and fixing it with the snaps. Accordingly, the Patent Office considered that the diaper of Wilson inherently has an ability to be rolled up and fixed after use and decided that the claimed diaper is anticipated by the diaper of Wilson. The Federal Circuit, however, held that it is recognized that the constitution of the invention is inherently present in the prior art, only when it is clearly shown that the constitution of the invention is necessarily present in the prior art by external evidence. The invention can not be rejected based on "inherency" because of probability or possibility of the presence of the constitution in the prior art. Also see *Crown Operations International Ltd. V. Solutia* 24 USPQ 2d 1917 (Fed. Cir. 2002).

Claims 9, 10, 14 and 15 were rejected under 35 USC 103(a) as being unpatentable over Hoffarth et al. in view of U.S. Patent 4,755,911 to Suzuki. Suzuki fails to overcome the above discussed deficiencies of Hoffarth with respect to rendering unpatentable the present claims.

Suzuki does not suggest an interposer comprising dielectric layers disposed about an internal electrically conductive layer. Suzuki merely suggests employing a porous, expanded polytetrafluoroethylene. Moreover, Suzuki requires adhesive dots to bond the PTFE, which is contrary to the objectives of the present invention.

Accordingly, even if, Suzuki were combined with Hoffarth, the present invention would still not be disclosed.

Application No.: 09/625,135

Docket No.: 20135-00290-US

Claim 17 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hoffarth in view of U.S. Patent No. 4,788,766 to Burger, et al. Burger, et al. was relied upon for a disclosure of laminating subassemblies employing temperatures of at least 155°C, a time of 15 minutes and a pressure of 125 psi.

Burger, et al. fail to overcome the above discussed deficiencies of Hoffarth with respect to rendering unpatentable the present invention. Therefore Claim 17 is patentable for at least those reasons as to why Claim 8 is patentable.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Dated: 12-15-03
#288_1

Respectfully submitted,

By 

Burton A. Amernick

Registration No.: 24,852

CONNOLLY BOVE LODGE & HUTZ LLP

1990 M Street, N.W., Suite 800

Washington, DC 20036-3425

(202) 331-7111

(202) 293-6229 (Fax)

Attorneys for Applicant